

## REMARKS / ARGUMENTS

For the convenience of the Examiner and clarity of purpose, Applicant has reprinted the substance of the Office Action in *10-point bolded and italicized font*. Applicant's arguments immediately follow in regular font. In general, Applicant does not accede to the Examiner's characterization of the cited prior art or the structure of Applicant's claims unless such agreement is expressly stated below.

*1. The information disclosure statement (IDS) submitted on 24 March 2005 was been considered in part. The non-patent literature listed on page four of the document have not yet been scanned this are not viewable by the examiner. Upon those references being scanned into the case, the examiner will consider the references not initialed. Should any reference prove to be usable to reject any of the claims, the next Office Action will not be made final.*

Applicant thanks the Examiner for considering the references as indicated by initials on the returned Forms 1449. It is believed that scanned copies of those non-patent references that the Examiner has not yet been able to consider may be found associated with pending application serial nos. 10/364,945 and 10/364,941.

*2. The drawings are objected to because Figures 5A-5E and 6A-6E because each corresponding "figure" is actually only on figure and should be labeled as such, i.e. Figures 5AA and 6A are the same figure and should be labeled as one figure. The examiner recognizes that applicant is attempting to compare the location of the different elements of the tool for two different tool positions, however, this comparison can be shown in only one figure. The actual figures themselves need not be changed but only labeled as a single figure and the Brief Description of the Drawings changed accordingly. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where*

*necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.*

While it is true that the portions of the tools depicted in Figures 5A and 6A seem to be identical, Applicant submits that misses the point. Figure 5, which comprises Figures 5A through 5E, depicts a tool in the opened condition. Figure 6, which comprises Figures 6A through 6E, depicts a tool in the closed condition. Thus, while the figures may share a common centerline, for purposes of this application Figure 5 and Figure 6 depict different structures, regardless of any similarity between Figures 5A and 6A.

The undersigned contends that the overall disclosure is most clear by leaving Figures 5 and 6 as they are. The undersigned notes that the Examiner has not cited a rule or case law that purports to control this situation. Thus, unless the undersigned has again misunderstood the Examiner's position, or fails to appreciate the controlling rules or law, Applicant must respectfully decline the Examiner's request to modify Figures 5A and 6A.

**4. Claims 27, 28, 30, 38, 39, 41-43, 46, 49, and 64 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson, Jr. (US 4,429,747).**

***Regarding claim 27: Williamson, Jr. discloses an isolation system that includes an isolation pipe 11 that includes a pressure activated valve 63 coupled to the pipe and a tool shiftable valve 24 coupled to the pipe and in communication with the pressure activated valve (3:35-47).***

***Regarding claim 28: The tool shiftable valve is a sliding sleeve that is shiftable between an open and closed position.***

***Regarding claim 30: The isolation pipe defines a port 22 through which fluid is allowed to flow when the tool shiftable valve is open.***

U.S. Patent No. 4,429,747 to Williamson ("Williamson") discloses a mechanically shiftable sliding sleeve valve 10 that permits fluid flow from outside of the valve (e.g., annulus) to inside the valve (e.g., tubing) and vice versa. The flow is established through only one flow path, which flow path comprises ports 22 and slots 26. In addition, the valve 10 is initially configured with a pressure actuated sleeve 63 that closes off flow through ports 22. In use, the valve 10 becomes operational (i.e. can establish flow through the flow path) only after the pressure actuated sleeve 63 is moved to the opened position. Once opened, the pressure actuated sleeve 63 is never operated again. Once the pressure actuated sleeve 63 is actuated and the ports 22 are uncovered, the mechanically shiftable sleeve 24 may be shifted to open and close the flow path through the set of ports 22 and 26. Thus, among other things, Williamson only establishes fluid flow through one flow path, i.e., ports 22 and slots 26.

Claim 27 has been amended to make plain that the pressure activated valve, regardless of whether it is an annular flow valve or a circulation valve, or some other type of pressure activated valve, controls a first flow path, and the tool shiftable valve controls a second flow path. Nowhere in Williamson is this structure for controlling two or more flow paths disclosed or taught. Thus, Applicant submits that claim 27 is patentable over Williamson and dependent claims 28 and 30 are, therefore, patentable. Claims 28 and 30 have not been amended in response to this rejection. Reconsideration of these rejections is respectfully requested.

***Regarding claims 38, 64: Williamson, Jr. discloses a method for using the above system that involves inserting the tool into a wellbore, shifting the tool shiftable valve, and opening the pressure activated valve by pressurized fluid acting on the valve.***

***Regarding claim 39: The pressure activated valve is opened while the tool shiftable valve is in the wellbore.***

***Regarding claim 41. The pipe includes an isolation string.***

*Regarding claim 42. Production fluid is allowed to flow through both valves.*

*Regarding claim 43: The tool shiftable valve is shifted using a shifting tool.*

As presented, claims 38 and 64 require that the tool shiftable valve be shifted *before* the pressure activated valve is actuated. Williamson discloses and teaches the exact opposite; namely, Williamson discloses and teaches that the pressure actuated sleeve 63 must be pressurized to shear the lock out pin 70 and uncover the ports 22 before the mechanical sleeve 24 is shifted. In fact, Williamson takes great effort to discuss why shifting the sleeve 24 before pressurizing the sleeve 63 is not appropriate:

It is readily understood that one advantage of the device just described is that the ports 22 are initially closed but can be opened by application of mud pressure to the annulus, *thus making it unnecessary to run tools or drop plugs into the tubing at this time when the tubing is full of mud.* Tools do not fall through the mud readily, nor do they operate as efficiently in mud as compared to water or oil. It is further understood that *after* the mud pressure has caused the ports 22 to open and the mud is displaced from the tubing through the ports 22, *the shifting tool may be run into the well, the tubing now filled with water, and its work easily accomplished since these tools work much better in water than they do in mud.* In this manner, much time and expense is saved, and this could be considerable in view of the fact that many wells are now being drilled offshore from expensive platforms or expensive drill ships or semi-submersible structures where operations run into the thousands of dollars per hour. Also, most such wells have deviated bores making it even more desirable to have water or oil in the tubing when carrying on tool operations therein.

Williamson, Col. 8, line 54 – Col. 9, line 7 (emphasis added). Moreover, shifting the sleeve 24 before the pressure sleeve 63 is opened is wasted activity, since no flow path can be established.

Thus, Applicant submits that claims 38 and 64 are patentable over Williamson as presented and dependent claims 39 and 41 - 43 are, therefore, patentable. Claims 38, 39, 41 – 43 and 64 have not been amended in response to this rejection. Reconsideration of these rejections is respectfully requested.

***Regarding claim 46: The method further includes stinging a production string into the isolation string. The examiner notes that the method of claim 46 does not include any language that requires the steps be performed in a certain order. Further, the tubing string connecting the isolation string to the surface is being considered a production string that is "stung" into the isolation string prior to being run into the wellbore.***

***Regarding claim 49: The shifting tool is removed from the wellbore after shifting the tool shiftable valve.***

Applicant has chosen to amend claim 46 by requiring that "opening the pressure activated valve" occur *after* "shifting the tool shiftable valve with a shifting tool." For the reasons presented above with respect to claims 38 and 64, claim 46 and dependent claim 49 are patentable over Williamson. Claim 49 has not been amended in response to this rejection. Reconsideration of these rejections is respectfully requested.

**5.        *Claims 1, 2, 23-26, 55-63, and 65 are allowed.***

Applicant thanks the Examiner for her consideration and allowance of these claims.

**6.        *Claims 29, 31-37, 40, 44, 45, 47, and 48 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.***

From the Office Action Summary, it appears that claims 50-54 were likewise objectionable. Applicant thanks the Examiner for her consideration of these claims. However, at the present time and in light of the arguments and amendments presented above, Applicant chooses not to rewrite these claims.

**7.        *The objection to the drawings in paragraph 1 of the previous Office Action has been withdrawn as has the objection to the specification and the claims.***

Applicant thanks the Examiner for withdrawing these objections.

8. *Applicant's arguments with respect to claims 27, 28, 30, 38, 39, 41-43, 46, 49, and 64 have been considered but are moot in view of the new ground(s) of rejection.*

Applicant thanks the Examiner for her consideration of Applicant's arguments.

9. *The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.  
The remaining references made of record disclose various wellbore valves.*

### **Information Disclosure Statement**

Submitted herewith are two (2) Form 1449s listing 18 patents and 1 non-patent reference for consideration by the Examiner. Because this application was filed after June 30, 2003, and in accordance with the OG Notice dated August 5, 2003, copies of all U.S. Patents and Published Applications do *not* accompanying the IDS. Full consideration of these references is respectfully requested.

Applicant directs the Examiner's attention to the chart that was provided on March 22, 2005 and which shows the interrelationship of this application with other issued and co-pending applications, in compliance with MPEP 2001.06(b). Several of those applications have received recent Office Actions.

### **CONCLUSION**

The only fee thought to be due for this paper and its related submissions in the fee set forth in 37CFR § 1.17(p) in the amount of \$180 for submission of the IDS. If Applicant's belief is in error and one or more fees are due, the Commissioner is hereby authorized to change any fee necessary to make this and related papers timely and effective to deposit account 12-1322 (020569-05007).

Appl. No. 10/788,833  
Amdt. dated 10/18/2005  
Reply to Office action of 07/18/2005

P804-1242E-US

Applicant thanks the Examiner for her consideration and effort on this matter and submits that this application is now in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. The Examiner is invited to call the undersigned with any questions concerning this application.

Respectfully submitted,

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